



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/955,146	09/19/2001	Hiroshi Terasaki	289765/00	8297

21254 7590 11/26/2004
MCGINN & GIBB, PLLC
8321 OLD COURTHOUSE ROAD
SUITE 200
VIENNA, VA 22182-3817

EXAMINER

UPRETI, ASHUTOSH

ART UNIT PAPER NUMBER

2623

DATE MAILED: 11/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/955,146

Applicant(s)

TERASAKI, HIROSHI

Examiner

Ashutosh Upreti

Art Unit

2623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☒ Claim(s) 3-6 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 September 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Specification

The disclosure is objected to because of the following informalities: on page 6, at line 11, "that makes the client 3 to execute processing" is ungrammatical (deleting "to" would cure this problem); on page 7, at line 10, "by compressed in one file" is ungrammatical (changing this to "by being compressed in one file" would cure this problem); on page 7, at line 13, "makes the client 3 to select" is ungrammatical (deleting "to" would cure this problem); on page 14, at line 27, "does not the electronic" is ungrammatical (changing this to "does not match the electronic" may cure this problem); on page 24, at line 11, "verifies an instrument" and at line 17 "instrument verification" are not properly explained. It is unclear what is meant by these terms.

Appropriate correction is required.

35 U.S.C. 112, first paragraph, requires the specification to be written in "full, clear, concise, and exact terms." The specification is replete with terms which are not clear, concise and exact. The specification should be revised carefully in order to comply with 35 U.S.C. 112, first paragraph. Examples of some unclear, inexact or verbose terms used in the specification are: page 2, line 26 – page 3, line 4; page 14, lines 14-18; page 25, lines 1-4. These sections of the specification are written in a manner that does not clearly explain what is meant and appear to be poor translations, as they do not make grammatical sense.

Claim Objections

Claims 3, 4, 5 and 6 are objected to because of the following informalities: in claim 3, at lines 4-5, "the client who requests purchasing of data is verified to be a right decoder of encoded data" is written in a confusing manner; in claim 3, at line 12, "instrument verification" is unclear and needs to be explained further either in the claim or in the specification; in claim 4, at lines 3-4, "as a watermark information" is ungrammatical and unclear (removing "a" and explaining what is meant by "watermark information" would cure this problem); in claim 5, at line 16, "processing" is ungrammatical (changing this to process would cure this problem); in claim 6, at line 10, "processing" is ungrammatical (changing this to process would cure this problem). Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1 - 6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors. In claim 1, at lines 14-19, in claim 5, at lines 3-8 and in claim 6, at lines 5-10 the language is ungrammatical and it is unclear what is meant by these portions of the

Art Unit: 2623

claims. Correct use of punctuation and some further explanation is required to cure this problem.

Allowable Subject Matter

Claims 1 - 6 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

The following is an examiner's statement of reasons for allowance:

Claims 1, 5 and 6 all disclose the designation of high resolution data as output data when watermark information is detected, and the designation of low resolution data as output data when watermark information is not detected. This particular limitation in combination with the other claimed elements was not found in the prior art.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Takeo (U.S. Patent 6,675,210) discloses an image transmission system (Figure 5) comprising:

A client (column 3 line 18) comprising:

An image request section (Figure 5, S11) that requests transmission of image data;

An output instruction section that determines / instructs the output of an image data file (Figure 5, S14, S16, S18) and an output section that outputs the image data file (Figure 5, S15, S17, S19, S20).

A server comprising:

High resolution data as the image data file to be transmitted (Figure 5, S15, S17, S19).

A network that connects the client and the server (column 5, line 12).

Takeo also discloses the distribution of low resolution data (Figure 2c shows a part LL2 which is a low resolution portion of an image that is distributed) by the server via a network (Figure 1, parts 2 and 7).

Regarding a recording medium and computer program (claim 6), these are inherent in Takeo as the system uses an image server (Figure 1, 2).

Rabbani (European Patent Application EP 0705025 A2) discloses a watermark insertion section that inserts a watermark into low resolution parts of relatively higher resolution images (column 4, lines 14-17).

Wiser (U.S. Patent 6,385,596) discloses a data selection program (called a "media voucher" in this reference) (column 8, line 19), which is transmitted to the client (in this case a media player) (Figure 7A, 710, 712, 716). The media voucher is essentially the same as a data selection program as it is used by the client to identify the specific media data file to be acquired (column 8 lines 23-26). In addition, Wiser

discloses transmitting both the high resolution data and the low resolution data (column 4 lines 5-8) to the client. The invention disclosed in Wiser is considered relevant to image transmission as it deals with transporting "other digital media" (column 3, line 8) or "image data" (column 6 line 59) over the Internet.

Wiser also discloses a verification section that distributes a secret key when the client is verified to be the purchaser (Figure 6A, 612, 614, 616, 618, 620). Upon verification of purchase, the user receives a "passport" (Figure 6A, 620). This passport includes a "consumer private key" (Figure 4, 412) and a "registration key" (Figure 4, 420), which are considered to be secret keys.

Allowing decoding after the client is verified to be the purchaser is also disclosed in Wiser (column 4 lines 36-41). Here, the "passport" is required for the data to be decrypted, and since the client can only get the passport (and the included secret keys) after verification, the data is only decoded after verification.

Serret-Avila (U.S. Patent 6,785,815) discloses an image transmission system (Figure 2A) in which the server secretly holds a secret key (column 10 lines 38-41) that encodes the image. The invention describes a data transmission system but discloses its use for visual images as well (column 6 lines 22-24). The terms data and image shall therefore be interpreted as meaning the same thing in this reference. Also disclosed is a client that comprises a decoding section that decodes the encoded image (column 10 line 41, Figure 2B decryption section). The server distributes data including the encoded data (Figure 2A) and the secret key (column 10, line 40) via a network (Figure 1) when the client requests transmission of the image data file (the client

obtaining the data from the internet (column 7 line 1) is read as including the client having to request transmission). Also disclosed, is the use of the secret key for decrypting the encoded data (column 10, line 40). Serret-Avila discloses the inclusion of watermarks in the transmitted data (Figure 10, 1004, 1010).


Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ashutosh Upreti whose telephone number is (703) 306 4087. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amelia Au can be reached on (703) 308-6604. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A.U.
November 22, 2004


Jon Chang
Primary Examiner